

REMARKS

Entry of the foregoing and reexamination and reconsideration of the above-captioned application, as amended, pursuant to and consistent with 37 C.F.R. § 1.112, and in light of the remarks that follow, are respectfully requested.

Claims 1-40 stood rejected. Claims 1, 6, 7, 8, 10, 12, 13, and 21 have been amended and claims 2, 3, 9, 14-20, 23-31, 33, 34, 36, 37, 39 and 40 have been cancelled without prejudice or disclaimer to the filing of continuing applications relating to same.

Before commenting on the official action and this reply and amendment, applicant notes the filing of an Information Disclosure Statement on October 25, 2004. To date, applicant has not received an indication that the references contained therein have been considered. Applicant respectfully requests acknowledgement of same. A petition for a three-month extension of time is being submitted herewith.

In the official action, the examiner requested applicant amend the disclosure to include all materials incorporated by reference as they were deemed to be "essential material." As to that request, however, applicant respectfully disagrees.

The Patent Office, in summary fashion, has alleged that "essential material" has been omitted from the application. However, the Patent Office has failed to identify how the allegedly missing information is essential. Applicant notes that the specification has not been rejected pursuant to 35 U.S.C. § 112, first paragraph. Thus, the Patent Office has acknowledged, as it should in this instance, that a person of ordinary skill in the art is taught how to make and use the invention. Accordingly, nothing in the specification that has been incorporated by reference can be deemed "essential," and such materials need not be physically added to the specification.

Moreover, it is not proper for the Patent Office to, in a summary fashion, allege without further comment that each and every incorporation by reference in the specification contains "essential material." The Patent Office must individually explain how the specification is deficient in each instance in

such a way that the incorporation of the identified material is "essential."

In view of the fact that the specification has been found by the examiner to comply with 35 U.S.C. § 112, first paragraph and in the complete absence of any explanation as to why any particular incorporated material is "essential," applicant respectfully requests the withdrawal of the request.

Claims 13 and 31 were objected to as being in improper form. Claim 31 has been cancelled without prejudice or disclaimer, and therefore the objection as to that claim is moot. Claim 13 has been amended to clarify the language of the claim. However, it is not presented in a *Markush* format. There is nothing inherently indefinite or objectionable about alternate expressions in claims nor is there a requirement that *Markush* format be used in all instances.

Similarly, claims 10, 20 and 29 were also objected to as being in an improper *Markush* group. As claims 20 and 29 have been cancelled without prejudice or disclaimer, the objection is moot as to such claims. As to claim 10, applicant respectfully traverses. The claim is not in a *Markush* format. Therefore, it cannot be in an improper *Markush* format. There is nothing inherently wrong with alternative expressions in claims and the Patent Office has not pointed out how or why the use of alternate expressions in this instance would render the claim somehow indefinite to a person of ordinary skill in the art.

Furthermore, the examiner's statement that elements of a *Markush* group must be related is, of course, correct. To use the examiner's words, they must share a "common property." In the present case, all of the materials recited do share a common property, namely that they may all be used as additional ingredients along with the tetrapeptides and tripeptides of the present invention. Certainly those of ordinary skill in the appropriate art in the cosmetic and dermatopharmaceutical industries would appreciate that all of these ingredients may be formulated into various topically applied products. Under the circumstances, applicants respectfully submit that their grouping, even in a *Markush* group, is proper. Moreover,

applicant is unaware of any precedent, and the Patent Office has cited none, which suggests that a collection of materials such as recited in the claims, which are all useful as additives in the cosmetic and dermatopharmaceutical areas are an improper basis upon which to build a generic claim. Accordingly, applicant respectfully requests the withdrawal of the rejection.

Claims 9-22, 24, 26-33, 35, 37, 38 and 40 are rejected pursuant to 35 U.S.C. § 112, second paragraph for various reasons as allegedly being indefinite. The first such rejection was directed to claims 9 and 28. Both claims have been cancelled without prejudice or disclaimer and therefore the rejection is moot. Claims 13 and 31 were rejected as allegedly being vague and indefinite because it was, allegedly, unclear as to which active ingredients were being claimed. Claim 31 has been cancelled without prejudice or disclaimer and therefore it is respectfully submitted that the rejection as to that claim is moot. Claim 13 has been amended in a manner which applicant hopes is satisfactory to the examiner and, while not in *Markush* language, nonetheless is clear and definite.

Claims 15-20, 24, 26 and 29 recited the term "topical" and allegedly there was insufficient antecedent basis for same. While applicant respectfully disagrees, claims 15-20, 24 and 26-29 have been cancelled without prejudice or disclaimer and therefore the rejection as to those claims is moot.

Claims 10, 20 and 29 have been rejected for reasons previously discussed in connection with the examiner's objection to the same claims. Claims 20 and 29 have been cancelled without prejudice or disclaimer and therefore the rejection as to those claims is moot. As to claim 10, applicant respectfully submits that there is nothing that would be indefinite to a person of ordinary skill in this art. One of ordinary skill in the art would understand that these are all additional ingredients that may be used alone or in combination with other members of the list, depending upon the objectives of a particular formulation. As such, applicant respectfully submits that the claims are as clear and definite as the subject matter will allow and certainly would not be indefinite to a person of ordinary skill in this art. Should the examiner wish to propose

alternate language of equal scope, applicant will be happy to consider same.

As a final matter, the specification has been amended as the examiner has requested to indicate trademarks where appropriate. Please note that Sederma is a company's name and therefore an initial cap only may be appropriate. Moreover, if the examiner finds any that applicant missed, please let the undersigned know and they will be corrected. Applicant is unsure, however, why they have been required to add to the specification generic terminology to accompany trademarks. If the examiner will please point to the appropriate passages in the statutes or rules requiring same, applicant will endeavor to do so.

Turning to the prior art rejections, claims 1-12, 14-30, 32-37 and 39 stand rejected pursuant to 35 U.S.C. § 103(a) as allegedly being unpatentable over Renaissance cream, and several other references identified on page 5 of the official action.

Similarly, claims 13, 31, 38 and 40 are rejected pursuant to 35 U.S.C. § 103(a) as allegedly being unpatentable over the RC cream disclosure in view of publication 2000/0132845, U.S. Patent No. 6,596,761 and other references, including some identified on page 5 of the official action. See page 15 of the official action. Because of the length of these rejections, their complexity, the number of references, and the claim amendments, applicant will not repeat the rejections. However, as those rejections would apply to the claims as amended, applicant respectfully traverses.

The principal art relied upon by the examiner in all of the rejections are Internet print outs of a product from Ultra Aesthetics identified as Renaissance Cream. The Internet printouts suggest that the material in question contains an acyl derivatized tri- and tetrapeptide of the type described and claimed (claims 7 and 8) in the instant application and that they may be used for stretch mark removal. One of the two publications for Renaissance Cream has a copyright date of 2001 and based upon that copyright date, the examiner suggests that the disclosures constitute prior art. Applicant has been unable to confirm whether or not the product in question was in fact sold and/or whether or not in fact the product in question

contains the ingredients represented in the Internet literature. Indeed, the reference identified by the examiner as "RVC" is undated and therefore cannot be considered prior art. Nor can one assume that the content of the product referred in "RC" is the same as that referenced in "RVC" as they may be separated by years and nothing prevented reformulation at any time.

Applicant will assume, only for the sake of argument, that the Renaissance Cream information is legitimate and is prior art. But even under those circumstances, it does not teach or suggest the claimed invention nor render obvious the subject matter of the claims as amended. No information is provided as to the relative amounts of the ingredients used. Claim 1 as amended not only requires specific amounts of the various tri- and tetrapeptides but also requires that the amount of the tripeptide exceed that of the tetrapeptide. Neither of these claim limitations can be derived from the primary references or from any of the secondary art of record.

Nor is this a matter of mere optimization. Applicant has disclosed that combinations in accordance with the present invention can provide results which are superior to the use of either of the peptides alone (see pages 4-5) and indeed can provide synergistic results. See example 12.

Nothing in the art of record teaches or suggests this particular claimed combination of peptides in the amounts required in accordance with the present invention nor even teaches or suggests that the results obtained in accordance with the present invention can be obtained by the use of tri- and tetrapeptides as opposed to the many other active and otherwise inactive ingredients disclosed in the allegedly prior art formulation.

Turning to claims 12 and 13, as well as method claims 35 and 38, nothing in the art of record teaches or suggests the combination of the claimed tri- and tetrapeptides with rutin and Bowman Birk Inhibitor ("BBI"), or with berberine or chrysine, respectively, or their use as claimed to treat stretch marks, signs of skin aging or for reducing dark circles around the eyes. One cannot, as the Patent Office has done in this instance, merely cite to art that identifies these materials and then summarily, with no art of record as support, reject their

combination as being obvious. The Patent Office is reminded that many, if not most, inventions are made up of known constituents and that fact alone does not deprive them of patentability. The question is whether or not one of ordinary skill in the art would seek to combine these known ingredients in the manner claimed and as to claims 12 and 13 and the method claims depending therefrom. There is no evidence on the record to suggest that that is the case, and no evidence that the references are combinable and would lead to the claimed invention. Certainly, nothing in any of the references cure the deficiencies previously identified with regard to claim 1 as amended or to the combination with rutin, BBI, berberine or chrysine.

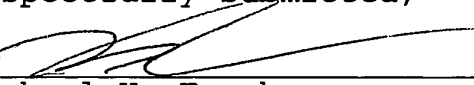
Should the examiner have any questions with regard to the foregoing, the examiner should contact applicant's attorney at the examiner's convenience at (908) 654-5000 in order to overcome any additional objections which he might have.

If there are any additional charges in connection with this requested amendment, the examiner is authorized to charge Deposit Account No. 12-1095 therefor.

From the foregoing, further and favorable action in the form of a notice of allowance is believed to be next in order and such action is earnestly solicited.

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Respectfully submitted,

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